



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

8

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/590,991 06/09/00 ADAMOU

J 469201-475

EXAMINER

HM12/0829

ALAN J GRANT ESQ
CARELLA BYRNE BAIN GILFILLAN CECCHI
STEWART & OLSTEIN
6 BECKER FARM ROAD
ROSELAND NJ 07068

DEVT. S.	
ART UNIT	PAPER NUMBER

1645
DATE MAILED:

08/29/01

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/590,991

Applicant(s)
Adamou et al.

Examiner
S. Devi, Ph.D.

Art Unit
1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 ~~is/are~~ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Serial No: 09/590,991
Art Unit: 1645

Restriction / Election

1) Claims 1-22 are under prosecution. Claim 21 is currently not placed in any of the restricted inventions, since it is confusing in being dependent from claim 20, yet reciting that "said antibody" is what is administered to the animal. Claim 20 is not directed to an antibody.

2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your election responses, which is able to receive transmissions 24 hours a day and 7 days a week. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3) Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a vaccine comprising a polypeptide having an amino acid sequence at least 65% identical to the amino acid sequence of SEQ ID NO: 6, classified in class 530, subclass 350.
- II. Claims 5-8, drawn to a vaccine comprising a polypeptide having an amino acid sequence at least 65% identical to the amino acid sequence of SEQ ID NO: 8, classified in class 530, subclass 350.
- III. Claim 13, drawn to an antiserum to the polypeptide of SEQ ID NO: 6, classified in class 530, subclass 387.9.
- IV. Claim 14, drawn to an antiserum to the polypeptide of SEQ ID NO: 8, classified in class 530, subclass 387.9.
- V. Claims 17 and 18, drawn to a method of preventing streptococcal infection by administering to an animal a polypeptide of SEQ ID NO: 6, classified in class 424, subclass 244.1.

Serial No: 09/548,947

Art Unit: 1645

- VI. Claims 17 and 18, drawn to a method of preventing streptococcal infection by administering to an animal a polypeptide of SEQ ID NO: 8, classified in class 424, subclass 244.1.
- VII. Claim 19, drawn to a method of preventing streptococcal infection by administering to an animal an antibody to the polypeptide of SEQ ID NO: 6, classified in class 424, subclass 165.1.
- VIII. Claim 19, drawn to a method of preventing streptococcal infection by administering to an animal an antibody to the polypeptide of SEQ ID NO: 8, classified in class 424, subclass 165.1.
- IX. Claim 20, drawn to a vaccine comprising a transformed microbial organism expressing Sp128 polypeptide, classified in class 424, subclass 93.4.
- X. Claims ²¹20, drawn to a vaccine comprising a transformed microbial organism expressing Sp130 polypeptide, classified in class 424, subclass 93.4.

Claim 16 is considered a linking claim and will be joined with one of inventions I and II.

Claims 9-12 and 15 are considered linking claims and will be joined with one of inventions III and IV.

Claim 22 is considered a linking claim and will be joined with one of inventions IX and X.

4) Inventions I through X are distinct from one another. Inventions I, II, III, IV, IX and X are directed to structurally and/or functionally or biologically distinct products: two distinct polypeptides; two antibodies with distinct specificity, and two transformed microbes expressing structurally and functionally distinct polypeptides. These inventions require separate non-coextensive searches.

5) Inventions I and V as well as inventions II and VI are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

Serial No: 09/548,947
Art Unit: 1645

process of using that product (M.P.E.P 806.05(h)). In the instant case, the polypeptide of inventions I and II can be used in a materially different process, for example, as a coating antigen in an *in vitro* diagnostic assay.

6) Inventions III and VII as well as inventions IV and VIII are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the antibody of inventions III and IV can be used in a materially different process, for example, as an assay reagent in an *in vitro* diagnostic assay.

The methods of inventions V and VI differ from the methods of inventions VII and VIII in the composition used. The products of inventions IX and X are not required to practice the methods of inventions V, VI, VII and VIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification/subclassification and divergent subject matter, and since a search performed for one would not be co-extensive for the other, restriction for examination purposes as indicated is proper.

7) Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R 1.143).

8) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R 1.48(b) and by the fee required under 37 C.F.R 1.17(h).

9) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile


Serial No: 09/548,947
Art Unit: 1645

transmission. Papers should be transmitted via the PTO Fax Center located in Crystal Mall 1. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The CM1 facsimile center's telephone number is (703) 308-4242, which is able to receive transmissions 24 hours a day and 7 days a week.

10) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


S. Devi, Ph.D.
Primary Examiner
August 2001



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: S. DEVI, Ph.D.

ART UNIT: 1645

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

THE DOCUMENT(S) ACCOMPANYING THIS FACSIMILE TRANSMISSION CONTAIN(S) INFORMATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH IS CONFIDENTIAL AND/OR LEGALLY PRIVILEGED. THIS INFORMATION IS FOR THE USE OF THE INDIVIDUAL OR FIRM NAMED ON THIS SHEET. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISCLOSURE, COPYING, DISTRIBUTION, OR THE TAKING OF ANY ACTION IN RELIANCE ON THE CONTENTS OF THIS INFORMATION IS STRICTLY PROHIBITED. THE DOCUMENTS SHOULD BE RETURNED TO THE PATENT AND TRADEMARK OFFICE IMMEDIATELY. IF THIS FACSIMILE IS RECEIVED IN ERROR, PLEASE NOTIFY THE ATTORNEY LISTED HEREON IMMEDIATELY.